

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1, 3, 5-7, 9-10, 12, 14-15, 18-25, and 30-32 were pending in the application, of which Claims 1, 18, and 32 are independent. In the Office Action dated October 27, 2008, Claims 18-25 and 30-31 were rejected under 35 U.S.C. § 101 and Claims 1, 3, 5-7, 9-10, 12, 14-15, 18-25, and 30-32 were rejected under 35 U.S.C. § 103(a). Following this response, Claims 1, 3, 5-7, 9-10, 12, 14-15, 18-25, and 30-32 remain in this application. Applicants hereby address the Examiner's rejections in turn.

I. Interview Summary

Applicants thank Examiner Long for the courtesy of a telephone interview on January 13, 2009, requested by the undersigned to discuss the rejection of the current claims under 35 U.S.C. §§ 101 and 103. During the interview, Applicants asserted that the cited references do not render obvious the claims as currently amended. In agreement, the Examiner stated that the amendments overcome the cited references, but that an updated search would be necessary. The Examiner further stated that the rejection under 35 U.S.C. § 101 has been overcome by this Amendment. No patentability agreement was reached.

II. Rejection of the Claims Under 35 U.S.C. § 101

In the Office Action dated October 27, 2008, the Examiner rejected Claims 18-25 and 30-31 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 18 has been amended and Applicants respectfully submit that the amendment overcomes this rejection and adds no new matter.

III. Rejection of the Claims Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1, 3, 5-7, 9-10, 12, 14-15, 18-25, and 30-32 under 35 U.S.C. § 103(a) as being unpatentable over “Outlook 2000 In a Nutshell: A Power User’s Quick Reference,” 2000 (“*Syroid*”) in view of “Sam’s Teach Yourself Microsoft Office Outlook 2003 in 24 Hours,” 2003 (“*Poremsky*”), Microsoft Outlook Screenshots, 2000 (“*Outlook*”), and U.S. Patent No. 6,101,485 (“*Fortenberry*”). Claims 1, 18, and 32 have been amended, and Applicants respectfully submit that the amendments overcome this rejection and add no new matter.

Amended Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, for example, “in response to determining that the electronic mail message was generated by the alert subscription, providing a user interface button for creating the electronic message handling rule, and upon selection of the user interface button for creating the electronic message handling rule, providing a user interface dialog box comprising a first portion for identifying conditions for the electronic mail handling rule and a second portion for identifying action associated with the conditions.” Amended Claims 18 and 32 each includes a similar recitation. Support for these amendments can be found in the specification at least on page 15, lines 1-21.

In contrast, and as stated by the Examiner, *Syroid* and *Poremsky* at least fail to disclose creating a message handling rule. (See Office Action page 6, lines 18-21.) Consequently, because *Syroid* and *Poremsky* do not disclose creating a message handling rule, *Syroid* and *Poremsky* cannot disclose providing a user interface dialog box for creating a message handling rule upon detecting a subscription alert. Accordingly, *Syroid* and *Poremsky* fail to disclose providing a user interface button and a dialog box for creating a message handling rule.

Furthermore, *Outlook* does not overcome *Syroid's* and *Poresmky's* deficiencies. For example, *Outlook* discloses that, while viewing a message, an option to create a rule is provided. (See Figure 3.) When the option to create a rule in *Outlook* is selected, message context is populated to create a condition based on the message context. (See Figure 4.) Nowhere does *Outlook* disclose receiving a subscription alert, much less parsing a message to detect the subscription alert. Consequently, *Outlook* cannot disclose providing a user interface dialog box for creating a message handling rule upon detecting a subscription alert. Rather, *Outlook* merely discloses rule creation provisions based on an option's selection.

Moreover, *Fortenberry* does not overcome *Syroid's*, *Poresmky's*, and *Outlook's* deficiencies. For example, *Fortenberry* merely discloses allowing a shopper to fill out and submit an order directly from an e-mail solicitation. (See col. 1, lines 58-60.) Nowhere does *Fortenberry* disclose receiving a subscription alert, parsing a message to detect the subscription alert, or creating a message handling rule. Consequently, *Fortenberry* cannot disclose providing a user interface dialog box for creating a message handling rule upon detecting a subscription alert. Rather, *Fortenberry* merely

discloses an extended capability for electronic solicitation referred to as an e-flyer. (See col. 1, lines 61-62.)

Combining *Syroid* with *Poremsky*, *Outlook*, and *Fortenberry* would not have led to the claimed invention because *Syroid*, *Poremsky*, *Outlook*, and *Fortenberry*, either individually or in combination, at least do not disclose or suggest “in response to determining that the electronic mail message was generated by the alert subscription, providing a user interface button for creating the electronic message handling rule, and upon selection of the user interface button for creating the electronic message handling rule, providing a user interface dialog box comprising a first portion for identifying conditions for the electronic mail handling rule and a second portion for identifying action associated with the conditions,” as recited by amended Claim 1. Amended Claims 18 and 32 each includes a similar recitation. Accordingly, independent Claims 1, 18, and 32 each patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claims 1, 18, and 32.

Dependent Claims 3, 5-7, 9-10, 12, 14-15, 19-25, and 30-31 are also allowable at least for the reasons described above regarding independent Claims 1 and 18, and by virtue of their respective dependencies upon independent Claims 1 and 18. Accordingly, Applicants respectfully request withdrawal of this rejection of dependent Claims 3, 5-7, 9-10, 12, 14-15, 19-25, and 30-31.

IV. Conclusion

In view of the foregoing, Applicants respectfully submit that the pending claims, as amended, are patentable over the cited references. The preceding arguments are based only on the arguments in the Official Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Official Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,
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